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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,778	08/24/2001	Nikhil M. Deshpande	884.491US1	2935
21186	7590	12/27/2004	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			JAMAL, ALEXANDER	
		ART UNIT	PAPER NUMBER	
		2643		

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/938,778	DESHPANDE ET AL.	
Examiner	Art Unit		
Alexander Jamal	2643		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 07 September 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-29 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this **National Stage** application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

R B
REXFORD BARNIE
PRIMARY EXAMINER

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Response to Amendment

1. Based upon the submitted amendment (9-7-2004), the examiner notes that claims 12,13,18,29 have been amended.
2. Examiner withdraws all previous rejections and submits a new set of rejections based upon a new set of prior art.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1,2,14-16, 21-22 rejected under 35 U.S.C. 102(e) as being anticipated by Waites (6788769).**

As per **claim 1**, Waites discloses a communication system that may comprise an IM system (Col 1 lines 10-20). The system comprises an origin device where a user is able to input text or speech (Col 3 lines 29-46) or convert input speech to text in order to be transmitted (Col 9 lines 36-50).

As per **claim 14**, claim rejected for same reasons as rejection of claim 1. Additionally, Waites' originating device inherently comprises a controller to determine whether a speech option is selected for the purpose of being able to correctly coordinate the operation of the IM server interface and the speech-to-text converter.

As per **claim 21**, claim rejected for same reasons as rejection of claim 19. The terminals inherently comprise software on a signal bearing medium for the purpose of controlling the terminal hardware.

As per **claims 2,22** claims rejected for same reasons as claim 1,21 rejections.

As per **claim 15**, when the IM transmitted, it will be sent/received across a long-lived connection (the interface between the sending terminal and the network connected to the IM server).

As per **claim 16**, the IM server will pass along an IM to the destination device.

5. **Claims 6-10,12** rejected under 35 U.S.C. 102(e) as being anticipated by Andrews et al (6522878).

As per **claims 6,7**, Andrews discloses a method comprising receiving an instant message (alphanumeric page) comprising text at a destination device, then converting that text into speech if the speech option is selected (pager mode announce) (Col 4 lines 12-22).

As per **claims 10,8**, claims rejected for same reasons as claim 6. Additionally, Andrews' method will receive and convert the text independently of the manner in which the sender of the page input the text.

As per **claims 9,12**, when the page is transmitted and received via the cellular network, the pages will be sent/received across a long-lived connection (the interface between the cellular access point and the cellular network).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 3-5,18,23-25** rejected under 35 U.S.C. 103(a) as being unpatentable over Waites et al. (6788769) as applied to claims 1,2,14,21,22, and further in view of Andrews (6522878).

As per **claim 3**, Waites discloses applicant's claims 1,2,14,21,22, but does not specify that the receiving pager comprise a speech option to convert incoming text into speech.

Andrews discloses a pager with a text-to-speech converter (Col 4 lines 10-20). He also teaches that a text-to-speech interface may provide the user a more efficient way of receiving text messages (Col 1 lines 30-40). It would have been obvious to one of ordinary skill in the art at the time of this application that the receiving pager of Waites' system could comprise a text-to-speech converter for the advantage of providing a user with an additional interface (hearing) to communicate with.

As per **claim 4**, claim rejected for same reasons as claim 3 rejection.

As per **claims 5,25**, the message delivery interface at the receiving device is independent of the message inputting interface at the sending device.

As per **claims 18,23,24**, claim rejected for same reasons as claim 3 rejection.

8. **Claims 19,20,26-29**, rejected under 35 U.S.C. 103(a) as being unpatentable over Waites et al. (6788769), and further in view of Andrews (6522878).

As per **claim 19**, Waites discloses an IM system as per the claim 1 rejection.

However, Waites does not disclose the destination client device comprising a text-speech converter to convert the received messages into speech.

Andrews discloses a pager with a text-to-speech converter (Col 4 lines 10-20). He also teaches that a text-to-speech interface may provide the user a more efficient way of receiving text messages (Col 1 lines 30-40) independently of how they were sent. It would have been obvious to one of ordinary skill in the art at the time of this application that the receiving pager of Waites' system could comprise a text-to-speech converter for the advantage of providing a user with an additional interface (hearing) to communicate with.

As per **claim 26**, claim rejected for same reasons as rejection of claim 19.

As per **claim 20**, claim rejected for same reasons as claim 19.

As per **claim 27**, claim rejected for same reasons as claim 1.

As per **claim 28**, claim rejected for same reasons as claim 15.

As per **claim 29**, Waites discloses that the message may be sent as an email message (request-reply pair) (Col 1 lines 14-20).

9. **Claim 17** rejected under 35 U.S.C. 103(a) as being unpatentable over Waites et al. (6788769) as applied to claim 14, and further in view of Ogle et al. (6430604).

As per **claim 17**, Waites discloses applicant's claim 14, but does not specify that the IM server drops the messages when no destination client device is connected.

Ogle discloses an IM system in which the messages may be dropped if the receiving device is not available (Col 3 lines 20-35). It would have been obvious to one of ordinary skill in the art at the time of this application that an IM server could drop a message if the receiving device were not connected for the reason that the server not get overloaded with undelivered messages.

10. **Claims 11,13** rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews et al (6522878) as applied to claim 10, and further in view of Waites (6788769).

As per dependant **claim 11**, Andrews discloses applicant's claim 10 but does not disclose determining whether a speech option is chosen at the origin (sender) device and when selected, converting input speech to text.

Waites discloses a communications system that may comprise instant messaging (paging) (Col 1 lines 10-20). He discloses that the user may be able to dictate a voice message that is sent through a speech-to-text converter (Col 9 lines 35-51). It would have been obvious to one of ordinary skill in the art at the time of this application that the sending device could comprise a speech-to-text converter for the purpose of providing an additional interface for the sender (ie. the sender may dictate a voice message that may be sent to a receiving pager).

As per **claim 13**, Waites discloses that the message may be sent as an email message (request-reply pair) (Col 1 lines 14-20).

Response to Arguments

11. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 703-305-3433. The examiner can normally be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 703-305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9315 for After Final communications.


REXFORD BARNIE
PRIMARY EXAMINER

AJ
December 14, 2004